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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,389	12/15/2003	Thomas E. Creamer	BOC9-2003-0088 (459)	6219
40987	7590	09/11/2008		
AKERMAN SENTERFITT			EXAMINER	
P. O. BOX 3188			NOONAN, WILLOW W	
WEST PALM BEACH, FL 33402-3188			ART UNIT	PAPER NUMBER
			2146	
			MAIL DATE	DELIVERY MODE
			09/11/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/736,389	CREAMER ET AL.
	<b>Examiner</b>	Art Unit
	WILLOW NOONAN	2146

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 12 May 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/S/65/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The instant application having Application No. 10/736,389 has a total of 24 claims pending in the application; there are 8 independent claims and 16 dependent claims, all of which are ready for examination by the examiner.

***Response to Patent Eligibility Arguments***

2. Applicant's arguments filed 5/12/2008 have been fully considered but they are not persuasive.

Applicant argues that "the specification describes various devices that possess communications and processing capabilities ... [and that] the claims should be interpreted in [that] context. However the corresponding descriptions in the specification are non-limiting. *See, e.g.*, present application at paragraph 17 ("any [emphasis added] communication device configured as described herein can be used").

***Response to Patentability Arguments***

3. Applicant's arguments filed 5/12/2008 have been fully considered but they are not persuasive.

Applicant **first** argues that Jones nowhere describes the request being generated or formed using data obtained over a mobile communication link of a mobile communications network.

Jones does teach that the request is formed using data obtained over a mobile communication link of a mobile communications network. See Jones at p. 2, paragraph 22 ("might identify service provider system and might provide a username and password"). Examiner further notes that this limitation as *claimed* constitutes non-functional descriptive material and is not given any weight for patentability purposes.

Applicant **next** argues that Faccin fails to teach or suggest using both a mobile communications link over a mobile network *and* a wireless communications link over a wireless network. However, Applicant has failed to limit the definitions of these two types of networks such that the distinction may be given weight for patentability purposes. See present application at paragraph 12 ("The wireless network **can** be ... including, **but not limited to**); present application at paragraph 13 ("The mobile network ... **can** include ... including, **but not limited to**").

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The "system" claimed in each of claims 12-18 could be interpreted in a manner consistent with Applicant's specification as solely software. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. A computer program is

not clearly a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jones** (U.S. Patent App. Pub. No. 2003/0212800) in view of **Applicant's admitted prior art** (hereafter "AAPA"), **Faccin** (U.S. Patent App. Pub. No. 2003/0014668), and **Pailer** ("A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system").

Regarding claims 1, 7, 10, 16, and 19, Jones teaches a method of authenticating a mobile communication device comprising forming a referred by token using authentication data provided by a mobile service provider over a mobile communications link over a mobile communications network. See Jones at p. 2, paragraph 22 ("the subscriber station then sends an authentication request message into the access network, identifying both (i) a designated one of the service provider

systems (e.g., a service provider ID, for instance) and (ii) one or more authentication credentials (such as subscriber ID (e.g., user ID or station ID) and password."). Jones teaches sending the token to an authentication server via a wireless communications link over a wireless network, wherein the authentication server sends a request for validation, built using the token, to the mobile service provider. See Jones at p. 2, paragraph 23 ("the access network then sends the authentication request message (possibly reformatted or changed in some respect) to the authentication entity of the service provider system designated by the request."). Jones teaches receiving a reply from the authentication server over the wireless network communications link, wherein the reply indicates whether the request for validation from the authentication server was confirmed. See Jones at p. 2, paragraph 24 ("the authentication entity will send an authentication response message to the access network").

Jones does not teach that the authentication server is a Session Initiation Protocol (SIP) server or that the request for validation uses Parlay. However, Faccin teaches that it is well known to use SIP for authenticating communication devices in a network. See Faccin at fig. 1. It would have been obvious to one of ordinary skill to use Faccin's technique in Jones' system because Faccin teaches that the disclosed technique may be used to authenticate a subscriber in a mobile terminated call to increase system security. See Faccin at p. 1, paragraph 10.

Pailer teaches that it is well known map SIP functionality to Parlay services. See Pailer, *Abstract*. It would have been obvious to use Pailer's technique in Jones' system

because Pailer teaches that the use of the Parlay APIs may speed up application development and increase interoperability. See Pailer, *Abstract*.

Regarding claims 4, 13, and 22, Jones teaches a method of authenticating a mobile communication device comprising receiving a referred by token from the mobile communication device over a wireless communications link over a wireless network, wherein the token was built using authentication data provided by a mobile service provider received over a mobile communications link over a mobile communications network. See Jones at p. 2, paragraph 22 ("the subscriber station then sends an authentication request message into the access network, identifying both (i) a designated one of the service provider systems (e.g., a service provider ID, for instance) and (ii) one or more authentication credentials (such as subscriber ID (e.g., user ID or station ID) and password."). Jones teaches interpreting the token, forming a request using data specified by the token, and sending a request for validation of the mobile communication device to the mobile service provider. See Jones at p. 2, paragraph 23 ("the access network then sends the authentication request message (possibly reformatted or changed in some respect) to the authentication entity of the service provider system designated by the request."). Jones teaches receiving a response from the mobile service provider and sending a reply to the mobile communication device over the wireless network communications link indicating whether the request for validation was confirmed. See Jones at p. 2, paragraph 24 ("the authentication entity will send an authentication response message to the access network").

Regarding claims 2-3, 5-6, 8-9, 11-12, 14-15, 17-18, 20-21, and 23-24, AAPA teaches that it is well known to use a wireless network that is compliant with at least one of an 802.16, 802.20, or 802.15 wireless communications protocol. See present application at p. 2. Further, Jones teaches that the wireless network is compliant with an 802.11 wireless communications protocol. See Jones at p. 2, paragraph 21.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLOW NOONAN whose telephone number is (571)270-1322. The examiner can normally be reached on Monday through Friday, 7:30 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. N./  
Examiner, Art Unit 2146

/Joseph E. Avellino/  
Primary Examiner, Art Unit 2146